C_1-C_4 monohydroxyalkyl radicals, C2-C4 polyhydroxyalkyl radicals, C_1-C_4 aminoalkyl radicals, cyano (C_1-C_4)alkyl radicals, and C_1-C_4alkoxyalkyl radicals;

provided that at least one, and only one, of R_1 and R_2 is hydrogen; and

(b) a coupler chosen from 1,3-bis(β-hydroxyethyl) amino-2-methylbenzene and the addition salts thereof with an acid;

wherein said composition does not include an oxidation base chosen from pyrimidine, pyrimidine derivatives, 2-β-hydroxyethyl-para-phenylenediamine, an addition salt thereof with an acid, and 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol, and

a second compartment that contains an oxidizing composition.

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-18 are pending in this application. Claims 1, 13, and 18 have been amended. No claims have been cancelled by this amendment. No new matter has been added for reasons which are discussed below.

II. INTERVIEW SUMMARY

Applicant wishes to thank Examiner Einsmann for the courtesies extended to Applicant's representatives during the personal interview of May 15, 2001. As stated in the interview summary, regarding the Lim '584/Akram combination, it was agreed that if Applicant could find support for excluding the specific base taught by Lim '584, then the rejection would be overcome. Regarding the Lim '438/Akram combination, it was agreed that Lim fails to teach or suggest the fluoro substituted base, as claimed. Therefore, pending an updated search, the claims would be allowable over the Lim '438/Akram rejection.

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III. THERE IS SUPPORT FOR THE AMENDMENTS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1, 13, 18 have been amended to include the proviso that the oxidation base 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol is excluded from the composition. Applicants believe that the proviso is fully supported by the specification as filed. Applicants are simply claiming less than the full scope of their disclosure, which is a perfectly legitimate procedure since it is for the inventors to decide what bounds of protection they will seek. Moreover, Applicants respectfully submit that *In re Johnson*, 194 U.S.P.Q. 187 (C.C.P.A. 1977) provides legal precedent for the addition of this proviso.

The fact pattern in the present case is analogous to the fact pattern in *Johnson*. As in *Johnson*, Applicants are including a proviso in the claims that excludes certain compounds taught by the prior art. Additionally, in *Johnson* and in the present case, a broad and generic disclosure of the excluded compounds is set forth: In *Johnson*, a broad class of precursor compounds with specific examples was disclosed; in the present specification, a class of oxidation bases with specific examples was disclosed. Based on these common underlying factors, Applicants respectfully submit that *Johnson* is analogous to the present case.

Johnson requires that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" must be present to support the exclusion of specific compounds. *In re Johnson* at 196. Applicants respectfully submit that such a broad and complete generic disclosure is set forth in this application. The specification and claims as originally filed set forth specific compounds that are not excluded by the new proviso. As in *Johnson*, this fact provides sufficient

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evidence that Applicants considered the subject matter of the presently claimed invention to be within the scope of their invention, and the new proviso is not new matter for this reason.

Moreover, adequate written description, particularly with respect to provisos, does not require literal support for the claimed invention. *In re Wertheim,* 191 U.S.P.Q. 90, 98 (CCPA 1976). The originally filed disclosure provides support as long as it would have reasonably conveyed to one having ordinary skill in the art that an applicant had possession of the concept of what is now claimed. *In re Anderson*, 176 U.S.P.Q. 331, 336 (CCPA 1973).

In the present case, Applicants respectfully submit that the specific oxidation base to be excluded by the new proviso would have been apparent to one of ordinary skill in the art after reading the present specification. In fact, the specification discloses the radicals necessary to arrive at the excluded species of oxidation base. For example, see page 4 of the specification. Accordingly, the compounds sought to be excluded by the proviso would have reasonably been conveyed to one having ordinary skill in the art.

Thus, the proviso added to claims 1, 13, and 18 has introduced no new concepts; but merely excludes a species from the original genus. The proviso, therefore, is fully supported in the specification and introduces no new matter.

IV. REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Lim '584 in view of Akram et al.

Claims 1-9 and 12-18 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,980,584 (Lim '584), in view of U.S. Patent No. 5,230,710

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(Akram). The rejection was made for the reasons cited at page 2 of the Office Action, mailed December 22, 2000.

In response to this rejection, Applicants have amended the claims to exclude 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol, in accordance with the agreements reached during the above mentioned interview. Lim '584 specifically and narrowly discloses 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol. Therefore, Applicant's assert that the Lim '584/Akram combination fails to teach or suggest the claimed invention, and withdrawal of the rejection is requested.

B. Lim '438 in view of Akram et al.

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being obvious over Lim U.S. Patent 6,074,438 (Lim '438) in view of Akram for the reasons set forth a pages 2 to 3 of the Office Action mailed December 22, 2000. Applicants respectfully traverse this rejection for the reasons of record, as well as for the reasons set forth below.

The Lim '438 and Akram references taken in combination fail to provide the requisite motivation that would have led the skilled artisan to choose Applicant's claimed composition. Each of the claims require at least one oxidation base chosen from the claimed formula (I) in combination with a coupler chosen from 1,3-bis(β-hydroxyethyl)amino-2-methylbenzene and an addition salt thereof with an acid. However, Lim '438 does not teach a composition containing a claimed oxidation base of formula (I) or a coupler chosen from 1,3-bis(β-hydroxyethyl)amino-2-methylbenzene and an addition salt thereof with an acid.

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Rather, Lim '438 teaches that developers (1) and (2) may be combined with

couplers (3) , (4), or (5). None of these developers or couplers fall within the scope of the oxidation bases or couplers of the instant claims. Lim '438 further teaches that additional dye ingredients may optionally be added and then sets forth an extensive laundry list of hundreds of possible "suitable" primary intermediates and/or couplers, one of which happens to be 1,3-bis(β-hydroxyethylamino)-2-methylbenzene (also known as 2,6-bis(hydroxyethlamino)-toluene). There is no motivation provided by Lim '438 that would have directed the ordinary artisan to choose the specifically claimed coupler from this long list. Further, Lim '438 teaches a preferred list of couplers which excludes the claimed 1,3-bis(β-hydroxyethylamino)-2-methylbenzene coupler. Therefore, the ordinary artisan, reading Lim '438 as a whole, would have been motivated to chose from the list of preferred couplers, rather then choosing the claimed 1,3-bis(β-hydroxyethylamino)-2-methylbenzene, if they were to choose from these optional couplers at all.

In order to make up for the deficiencies of Lim '438, the Office has relied upon Akram. However, similarly as discussed above, Akram adds to the list of possible couplers by reciting 2,6-diaminotoluenes in general, which may encompass many different couplers not claimed by Applicants. While Akram does list 1,3-bis(β-hydroxyethylamino)-2-methylbenzene as one of the preferred compounds, Akram entirely fails to teach or suggest that this compound should be combined with any of Applicants' claimed oxidation bases of formula (I). Instead, Akram lists six or more developer compounds which may be used which are different from the claimed oxidation base of formula (I). See Akram, column 9, lines 11-23. Therefore, taking Lim '438 and Akram in combination, there are literally thousands of possible combinations of

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oxidation bases and couplers, *none of which* fall within the scope of Applicants' claimed invention.

Despite this, the Office has asserted that the ordinary artisan would know to chose the 4-amino-2-chlorophenol developer of Lim '438 from the many developers listed in the Lim '438 and Akram references and then modify it by substituting the chlorine groups with fluorine and, in addition to this, choose to combine this modified developer with the single coupler claimed by Applicants that is listed in the literally hundreds of couplers named in Lim '438 and Akram. Applicants assert that the odds of the ordinary artisan making the necessary choices to arrive at the claimed invention from the teachings of Lim '438 and Akram are so small that this combination of references cannot possibly provide the requisite motivation necessary to support a *prima facie* case of obviousness.

Additionally, it should be pointed out that Lim '438 has specifically and narrowly disclosed and claimed 4-amino-2-chlorophenol for use with certain specified couplers to produce certain specific disclosed colors. See, for example, column 4, lines 28-31 and lines 47-51. There is absolutely no suggestion in Lim '438 to modify 4-amino-2-chlorophenol by substituting a fluoro-radical for the chloro-radical, as asserted by the Office. Where a compound is disclosed in such a specific and narrow manner as is the case here, Applicant's assert that it would not have been obvious to modify the compound without some suggestion in the art to do so.

For all of the reasons above, the Lim '438/Akram combination fail to teach or suggest the claimed invention. Therefore, the rejection should be withdrawn.

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V. OBVIOUS-TYPE DOUBLE PATENTING REJECTION

For the reasons discussed in the Amendment and Response dated October 19, 2000, Applicants respectfully request that the obvious-type double patenting rejections be held in abeyance until allowable subject matter is indicated in the instant application. Until such time, Applicants reserve the right to traverse the rejection or file a terminal disclaimer.

VI. CONCLUSION

In light of the above, Applicants respectfully submit that the pending claims are directed to allowable subject matter. An early and favorable action is respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 15, 2001

By: _____
Matthew Whipple
Reg. No. 47,217

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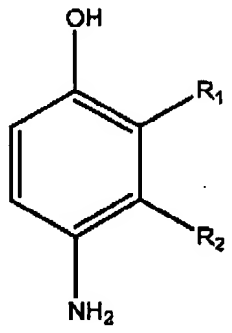
APPENDIX

This Appendix highlights the amendments made to the claims in the foregoing Preliminary Amendment of June 15, 2001.

1. A composition for the oxidation dyeing of keratin fibres comprising, in a medium which is suitable for dyeing:

(a) at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid:



(I)

in which:

R_1 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C_2-C_4 polyhydroxyalkyl radicals, C_1-C_4 alkoxyalkyl radicals, C_1-C_4 aminoalkyl radicals, and monohydroxy (C_1-C_4) alkylamino (C_1-C_4) alkyl radicals; R_2 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C_2-C_4 polyhydroxyalkyl

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radicals, C_1-C_4 aminoalkyl radicals, cyano (C_1-C_4) alkyl radicals, and C_1-C_4 alkoxyalkyl radicals; and

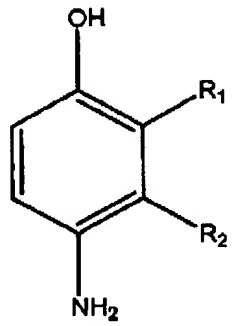
provided that at least one, and only one, of R_1 and R_2 is hydrogen; and

(b) a coupler chosen from 1,3-bis(β-hydroxyethyl) amino-2-methylbenzene and an addition salt thereof with an acid;

wherein said composition does not include an oxidation base chosen from pyrimidine, pyrimidine derivatives, 2-β-hydroxyethyl-para-phenylenediamine,[and] an addition salt thereof with an acid, and 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol.

13. A process for dyeing keratin fibres comprising the steps of 1) applying to said fibers at least one dye composition, and 2) developing a color at acidic, neutral or alkaline pH with the aid of an oxidizing agent which is added to the dye composition only at the time of use, or which is present in an oxidizing composition that is applied simultaneously with the dye composition or sequentially after application of the dye composition, said at least one dye composition comprising, in a medium which is suitable for dyeing:

(a) at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid:



(I)

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in which:

R_1 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C_2-C_4 polyhydroxyalkyl radicals, C_1-C_4 alkoxyalkyl radicals, C_1-C_4 aminoalkyl radicals, and monohydroxy (C_1-C_4) alkylamino (C_1-C_4) alkyl radicals;

R_2 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C_2-C_4 polyhydroxyalkyl radicals, C_1-C_4 aminoalkyl radicals, cyano (C_1-C_4) alkyl radicals, and C_1-C_4 alkoxyalkyl radicals;

provided that at least one, and only one, of R_1 and R_2 is hydrogen; and

(b) a coupler chosen from 1,3-bis(β-hydroxyethyl) amino-2-methylbenzene and an addition salt thereof with an acid;

wherein said composition does not include an oxidation base chosen from pyrimidine, pyrimidine derivatives, 2-β-hydroxyethyl-para-phenylenediamine, [and] an addition salt thereof with an acid, and 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol.

18. A multi-compartment dyeing kit comprising a first compartment that contains a dye composition for the oxidation dyeing of keratin fibres comprising, in a medium which is suitable for dyeing:

(a) at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid:

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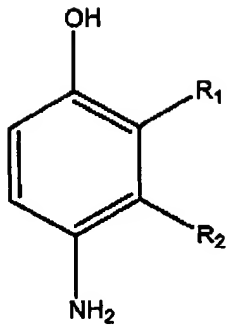

(I)

in which:

R_1 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C_2-C_4 polyhydroxyalkyl radicals, C_1-C_4 alkoxyalkyl radicals, C_1-C_4 aminoalkyl radicals, and monohydroxy (C_1-C_4) alkylamino (C_1-C_4) alkyl radicals;

R_2 is chosen from hydrogen, fluorine, C_1-C_4 alkyl radicals, C_1-C_4 monohydroxyalkyl radicals, C2-C4 polyhydroxyalkyl radicals, C_1-C_4 aminoalkyl radicals, cyano (C_1-C_4)alkyl radicals, and C_1-C_4alkoxyalkyl radicals;

provided that at least one, and only one, of R_1 and R_2 is hydrogen; and

(b) a coupler chosen from 1,3-bis(β-hydroxyethyl) amino-2-methylbenzene and the addition salts thereof with an acid;

wherein said composition does not include an oxidation base chosen from pyrimidine, pyrimidine derivatives, 2-β-hydroxyethyl-para-phenylenediamine, [and] an addition salt thereof with an acid, and 1-(5-amino-2-hydroxyphenyl)ethane-1,2-diol, and

a second compartment that contains an oxidizing composition.

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